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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,340	01/18/2002	Lou Chauvin	83304EF-P	9965
7590	11/26/2007		EXAMINER	
Milton S. Sales Patent Legal Staff Eastman Kodak Company 343 State Street Rochester, NY 14650-2201			CHANKONG, DOHM	
			ART UNIT	PAPER NUMBER
			2152	
			MAIL DATE	DELIVERY MODE
			11/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/051,340	CHAUVIN ET AL.
	Examiner	Art Unit
	Dohm Chankong	2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 July 2007.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 23-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 23-44 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

- 1> This action is in response to Applicant's amendment, filed 7.26.2007. Claims 1-22 are canceled. Claims 23-44 are added. Claims 23-44 are presented for further examination.
- 2> This is a final rejection.

Response to Arguments

- 3> Applicant's arguments with respect to claims 23-44 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 2152

4> Claims 23-44 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/050,979. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claims of the present application and the claims of the copending application are directed towards providing an offering based on a business relationship between a business entity and service provider. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5> Claims 23-44 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-19 of copending Application No. 10/051,342. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claims of the present application and the claims of the copending application are directed towards providing an offering based on a business relationship between a business entity and service provider. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6> Claims 23-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- a. Claims 23, 24 and 34 recite in relevant part basing purchasing information on “a ranking of a predefined business relationship.” While Applicant’s specification does discuss modifying purchase information, it does not discuss doing so based on a higher ranking. Applicant’s specification discusses the feature in conjunction with friendly or hostile relationships. One of ordinary skill in the art would not have interpreted these relationships as being analogous to a “higher” ranking. Therefore the claim should be amended to recite what is described in the specification.
- b. Claim 25 is rejected for reciting “modifying the primary purchasing information...if said ranking is higher.” See above.
- c. Claim 33 recites a “purchasing convenience feature.” Such a feature is not described in Applicant’s specification and therefore is rejected for failing to comply with the written description requirement.
- d. Claims 36 and 37 are rejected for reciting excluding merchants based on low rankings and lower prices based on higher rankings. These features are not expressly disclosed in Applicant’s specification. Applicant’s specification do recite some features that could be interpreted as similar to what is claimed, such as banning certain providers from a merchant’s terminal based on a hostile relationship between

the merchant and the provider and displaying lower prices of a service provider based on a more friendly relationship. However, the specification does not describe these features in relation to a ranking system. The claims should be amended to more claim what is described in Applicant's specification.

- e. Claim 43 is rejected for similar reasons set forth for claims 25, 36, and 37.
- f. Other claims are rejected based on their dependency on the rejected independent claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7> Claims 24, 29, 40, and 43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- g. Claim 24 is rejected for reciting "ordering a same product and/or service." It is unclear to what other claim element the "product and/or service" is supposed to be similar; it seems that "product and/or service" is referring to the "product and/or service" in claim 23. Claim 24 should be amended to more clearly define the relationship.

- h. Claims 29 and 40 are rejected for reciting a business entity and merchant, respectively comprising a variety of services related to digital images. It is unclear how a merchant can be "local printing" or "remote printing." Rather, the claims recite different services that a business entity or merchant might provide. Applicant's

specification supports this interpretation which discloses a “business entity” as a retailer.

- i. Claim 42 is rejected for reciting “said same product and/or service.” This should be amended to recite “said product and/or service.”
- j. Claim 43 is rejected for being confusing reciting “merchants that are excluded” are “selected according to the rankings.” It is unclear why merchants that are excluded are then selected.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

- 8> Claims 23, 25-27, 29, 31-34, 36, 37, 39-41, 43, and 44 are rejected under 35 U.S.C §103(a) as being unpatentable over Reifel et al, U.S Patent No. 7,013,288 [“Reifel”] in view of Anderson et al, U.S Patent No. 7,117,519 [“Anderson”].
- 9> As to claims 23, 34 and 44, Reifel discloses a method comprising:
providing a network service on a network [Figure 1];
allowing a user to access a network server via the network service for ordering

products using a network connected order terminal, said order terminal associated with one

of a plurality of business entities [Figure 1 | Figure 3 «item 308» | Figure 13 «items 20, 25»];

reading a portable digital device having an image stored thereon coupled to the
network connected order terminal by the user [Figure 13 «item 20»], the portable digital
storage device associated with one of a plurality of storage device providers [column 3 «line
53» to column 4 «line 4» : manufacturers providing a camera to the user], the plurality of
storage device providers each having a predefined business relationship with each of said
plurality of business entities [column 5 «lines 28-44» | column 12 «line 6»];

maintaining relationship data indicating a ranking of predefined business
relationships in a database coupled to the communication network [column 5 «lines 28-44» |
column 12 «line 6» : camera provider can restrict the vendors from which the consumer can
receive services]; and

displaying to the user an order screen on said order terminal including primary
purchasing information for ordering a product and/or service related to the image stored on
the portable digital storage device, the primary purchasing information being modified in
response to a ranking of a predefined business relationship between said one of the plurality
of storage device providers and said one of a plurality of business entities [column 5 «lines 11-
19 and 28-44» | column 12 «line 6» : Anderson discloses that a user may elect, by activating
links to print houses or vendors that are approved by the camera provider].

10> As to claims 25 and 37, Reifel discloses modifying the primary purchasing information to include a lower purchase price if said ranking is higher [column 5 «lines 28-44» | column 12 «line 6» : consumers receive cheaper prints at approved print houses or vendors].

11> As to claims 26 and 39, Reifel discloses said order terminal comprising one of the following, an automated teller machine, a kiosk, a personal computer, or a wireless device [Figure 13 «item 20»].

12> As to claims 27 and 41, Reifel discloses said portable digital storage device comprising one of the following: optical disc, magnetic floppy disk; flash memory device, or a digital camera [Figure 13 «items 5, 20»].

13> As to claims 29 and 40, Reifel discloses said one of a plurality of business entities comprises one or more of the following: local printing of digital images, remote printing of digital images, on-line storage of digital images, providing digital storage media containing digital images, and providing associated goods and/or services with respect to hard copy prints [column 5 «lines 28-44»].

14> As to claim 31, Reifel discloses a potential ranking of said predefined business relationships include at least two levels [column 5 «lines 28-44» : restricted vs. non-restricted print houses].

15> As to claim 32, Reifel discloses the step of maintaining relationship data is performed by a service manager using a table in a database of the server [Figure 13 «item 13»].

16> As to claim 33, Reifel discloses including or not including a purchasing convenience feature in the purchasing information in response to said ranking of a predefined business relationship between said one of the plurality of storage device providers [column 5 «lines 28-44» : approved print houses on an appropriate web page link].

17> As to claims 36 and 43, Reifel discloses excluding merchants based on low rankings of the business relationships between the providers and the excluded merchants [column 1 «lines 61-66» : unauthorized print houses read on excluded merchants].

18> Claims 24, 30, 35, and 42 is rejected under 35 U.S.C §103(a) as being unpatentable over Reifel, in view of Anderson et al, U.S Patent No. 7.117.519 ["Anderson"].

19> As to claims 24, 35 and 42, Reifel discloses:

reading a second portable digital storage device having a second image stored thereon coupled to the network connected order terminal by the user, the second portable digital storage device associated with a second one of the plurality of storage device providers [column 3 «lines 65-67» : camera providers];

displaying to the user an order screen on said order terminal including second purchasing information for ordering a same product and/or service but for the image stored

on the second portable digital storage device [column 5 «lines 29-44» : the discounts for prints based on the providers relationship with the print house].

Reifel does not disclose that the second purchasing information is different from the primary purchase information in response to a different ranking of a predefined business relationship between said second one of the storage providers and one of the business entities. However, Anderson discloses that such a feature was well known in the art at the time of Applicant's invention. Anderson specifically discloses that purchasing information for a second user is different from the purchasing information based on different business relationships between a camera provider and the business entity [column 5 «lines 17-37» | column 7 «lines 27-44» where : a camera provider disables certain features in the business relationship with the business entity such that the customers of one provider can or cannot print images].

It would have been obvious to one of ordinary skill in the art to have modified Reifel with Anderson's teaching of having different purchasing information for different users based on the relationships between providers and entities. One would have been motivated to modify Reifel to improve Reifel's photo-sharing system by providing customization based on the provider's relationships with the photo-sharing service.

20> As to claim 30, Reifel does disclose camera providers but does not expressly disclose the storage device including a digital code stored thereon for identifying its associated one of the plurality of storage device providers. However, Anderson discloses that this feature was well known in the art at the time of Applicant's invention. Anderson specifically discloses a

digital camera including an ID that identifies the digital camera's manufacturer [Figure 3 «item 28'»].

Anderson discloses that the code enables a service provider to properly identify and provide the services that were contracted for between the provider and the manufacturer [column 5 «lines 17-37»]. It would have been obvious to one of ordinary skill in the art to have modified Reifel to include Anderson's teaching of a manufacturer's code. Reifel discloses manufacturer specific services provided by print houses and therefore one would have been motivated to include Anderson's manufacturer code into the storage device to insure appropriate services are provided.

21> Claims 28 and 38 are rejected as being unpatentable over Reifel, in view of Vittal et al, U.S Patent No. 6,907,401 ["Vittal"].

22> As to claims 28 and 38, Roche does not expressly disclose displaying different types of products and/or service on the order screen for the user to select, wherein some of the products and/or services are displayed more prominently based on said ranking of a predefined business relationship between said one of the plurality of storage device providers and said one of a plurality of business entities.

However, Vittal discloses that such a feature was well known at the time of Applicant's invention. Vittal specifically discloses modifying purchasing information based on relationships between the merchant and a service provider such that the merchant's

Art Unit: 2152

product is displayed (advertised) more prominently [column 1 «lines 55-64» where : being advertised more prominently implies that that they are “displayed first”].

It would have been obvious to one of ordinary skill in the art to modify Roche to include Vittal's teachings of prominently displaying provider products on a merchant's site based on a contract between the merchant and the service provider. One would have been motivated to modify Roche as such functionality improves upon Roche's merchant-service provider system by increasing the number of options in the merchant-provider contract.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

See the PTO-892.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

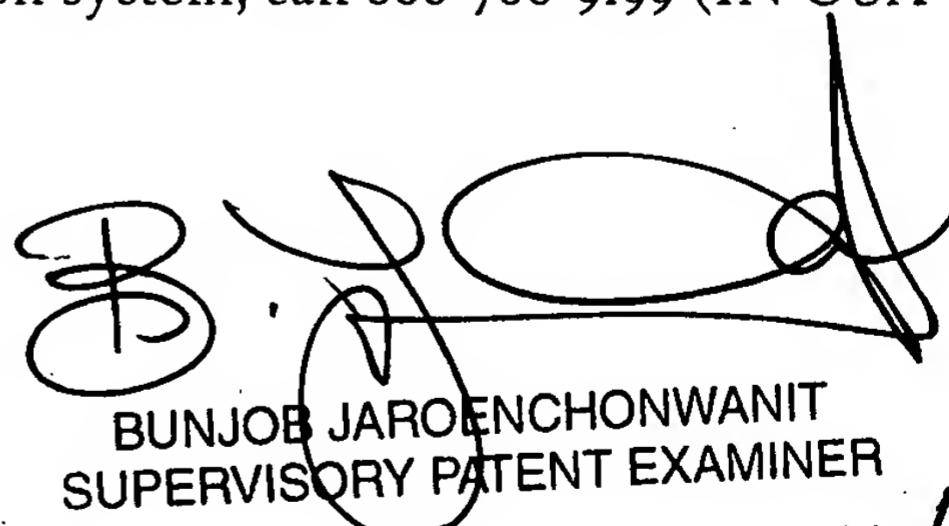
advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC


BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER

11/21/7